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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,431	12/30/1998	DANIEL S. KWOH	33853/PYI/I1	1638

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EXAMINER
CHIEU, PO LIN

ART UNIT	PAPER NUMBER
2615	

DATE MAILED: 03/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/223,431	KWOH ET AL.	
	Examiner	Art Unit	
	Polin Chieu	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-27 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in US on 4/26/96. It is noted, however, that applicant has not filed a certified copy of the PCT/US96/05767 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 5, 19, and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami (6,334,025).

Regarding claim 1, Yamagami discloses recording video programs on a recording medium (101); generating audio signals of titles for the recorded programs (fig. 5); recording the audio signals as voice titles (fig. 5); displaying on a screen a directory of the video programs recorded on the tape (fig. 5); selecting one of the video programs from the directory (col. 10, lines 50-65); and reproducing the voice titles to apprise a user of the voice titles of the selected video program (col. 11, lines 25-52). However, Yamagami does not disclose that the recording medium is a tape.

The examiner takes Official Notice that videotapes are a well known recording medium in the art.

It would have been highly desirable to use a videotape because they are much cheaper than the hard disc used by Yamagami.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use a videotape in the device of Yamagami.

Regarding claim 2-3, Yamagami et al teaches generating and recording the audio while the video is recorded (col. 8, line 35 to col. 9, line 23).

Regarding claim 5, Yamagami teaches having audio associated with a video program (fig. 5) recorded in the VBI (col. 8, lines 55-63).

Regarding claim 19, Yamagami additionally discloses playing the selected video program (col. 11, lines 5-25).

Regarding claims 20-21, Yamagami does not disclose that generation of the audio titles is done by speaking the titles into a microphone; and that this is done contemporaneously with the video recording.

The examiner takes Official Notice that it is well known to have a microphone in a camcorder to record an audio signal. Please refer to the art rejection of claim 3 for the discussion of recording of audio and video data at the same time.

It would have been highly desirable to have a microphone so that audio sound could be converted into audio signal allowing recording of the sounds. It would have been highly desirable to record audio and video data simultaneously so that the user does not have to record audio clips at some other time.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a microphone and record audio and video data simultaneously in the device of Yamagami.

Regarding claim 22-23, Yamagami discloses displaying voice title designations for the recorded video programs for which voice titles are recorded (fig. 5). Although figure 5 does not show the display of video without voice titles, Yamagami discloses that it is possible to only have video (col. 10, lines 50-55). Clearly video without voice titles would have an image icon displayed with the programs shown in figure 5.

Regarding claims 24-27, Yamagami teaches converting the voice titles to textual titles (col. 9, lines 25-30); displaying the textual titles (fig. 5); converting the voice titles to alphanumeric textual signals (col. 9, lines 25-30); and storing the alphanumeric text data into a RAM (col. 30-34).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami in view of Yuen et al (5,448,409).

Yamagami does not explicitly disclose recording the audio signal in the audio track.

Yuen et al teaches recording audio in an audio track in figure 4.

It would have been highly desirable to record according to format standards used for videotapes such as recording audio in an audio track.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to record audio in an audio track in the device of Yamagami.

5. Claims 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami in view of Birch et al (5,583,562).

Regarding claim 6, Yamagami does not disclose marking the end of the recorded audio signal.

Birch et al teaches marking the end on the recorded audio signal (col. 12, lines 14-29).

It would have been highly desirable to have a marker at the end of audio data so that the device can determine when the audio data has been completely read.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have markers at the end of audio data in the device of Yamagami.

6. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami in view of Birch et al and Yuen et al (5,488,409).

Regarding claims 7-12, Yamagami discloses recording audio related to video in an internal buffer and transferring to the VBI (col. 8, line 16 to col. 9, line 24). However, Yamagami does not disclose transporting the tape after the audio signal has been recorded; transferring the audio signal to a RAM for later use to select programs for playback; and other data including the location of the start of the recorded program and the length of the program.

Yuen et al teaches retrieving directory data from the VBI and transferring the data to a RAM (col. 7, line 60 to col. 8, line 6). The directory data is used to produce and on screen directory (fig. 34c) that allows the user to select a program for playback.

Yuen et al also discloses recording other data including tape location of the start of the recorded program and the length of a program (fig. 3).

The examiner takes Official Notice that it is well known to compress digital data to reduce the amount of data. It would have been obvious to digitize and compress the audio data before recording in the RAM.

It would have been highly desirable to record other data and audio data in a RAM so that the directory data could be quickly accessed (if it was stored in the VBI the tape would have to be rewound or fast forward to retrieve the directory data). It would have been highly desirable to digitize and compress the audio data to maintain a high quality signal while reducing the amount of data.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to record digitized and compressed audio data with other data.

7. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami in view of Birch et al, Yuen et al, and Ohno et al (5,761,371).

Regarding claims 13-15, Yamagami discloses recording audio clips (col. 10, lines 50-65), which are considered to be voice title designations. However, Yamagami does not disclose that the other data includes voice title designations with day and time, and length of a program.

Ohno et al teaches recording other data including length, day and time (fig. 4 and 5). As discussed previously, Yamagami discloses recording audio clips associated with video. Since the audio clips are used to identify the video clip, clearly it would have

been obvious to include length, day and time in these audio clips, which help identify the origin of a video clip.

It would have been highly desirable to have voice title designations and other data including the length, and day and time so that the video clip would be more easily identified.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have voice title designations and other data including the length and day and time in the device of Yamagami.

Regarding claim 16, Yamagami teaches recording the audio signal on the videotape while the video program is being recorded (col. 8, lines 55-63).

Regarding claims 17-18, Yamagami discloses reading and playing the video program responsive to other data (col. 11, lines 5-25). Clearly the tape would be positioned at the beginning of the video program to provide the program selected. The RAM was discussed in the art rejection of claims 7-11. Please refer to the art rejection of claims 7-11.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Doyle (6,058,239) discloses voice tags associate with a clip of video; and Ely (5,600,756) and Newlin (5,774,857) disclose converting audio to text. Henmi (5,390,027), Takahashi et al (5,124,814), Yuen (5,659,367), Mankovitz et al

(6,341,195), Yuen et al (6,147,715 and 6,091,884) are general directories for videotapes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Polin Chieu whose telephone number is (703) 308-6070. The examiner can normally be reached on M-F 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PC
March 22, 2002

ANDREW B. CHRISTENSEN
PRIMARY EXAMINER